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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/526,602      | 03/16/2000  | Yasuhiro Suda        | 54490-Z/JPW/DVD     | 1592             |

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EXAMINER

RODEE, CHRISTOPHER D

ART UNIT

PAPER NUMBER

1756

18

DATE MAILED: 04/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/526,602

Applicant(s)

SUDA ET AL.

Examiner

Christopher D RoDee

Art Unit

1756

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 14 April 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY [check either a) or b)]**

- a)  The period for reply expires 3 months from the mailing date of the final rejection.  
b)  The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.  
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1.  A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2.  The proposed amendment(s) will not be entered because:
  - (a)  they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b)  they raise the issue of new matter (see Note below);
  - (c)  they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d)  they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3.  Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4.  Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5.  The a) affidavit, b) exhibit, or c) request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6.  The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7.  For purposes of Appeal, the proposed amendment(s) a) will not be entered or b) will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 21-28.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8.  The proposed drawing correction filed on \_\_\_\_\_ is a) approved or b) disapproved by the Examiner.

9.  Note the attached Information Disclosure Statement(s) ( PTO-1449) Paper No(s). \_\_\_\_\_.

10.  Other: \_\_\_\_\_.

  
**CHRISTOPHER RODEE  
PRIMARY EXAMINER**

Continuation of 2. NOTE: the claims have not been previously considered where a coloring agent, without further limitation, and inorganic particles are stirred with a thermoplastic resin in the noted solvent while heating. The introduction of this new limitation at this point in prosecution requires a convincing showing under Rule 116 why the amendment is now presented and could not have been presented earlier. No such showing is of record. Applicants are also advised that even if the amendment were entered the carbon black in Hou may meet the requirements of both a coloring agent and inorganic particles because it is both of these. Thus a single component may meet the requirements of each claimed component.

Continuation of 5. does NOT place the application in condition for allowance because: the remarks are directed to the unentered amendments. Additionally, applicants are correct that Hou does not state that the SP values of the resin and the solvent are a factor in determining the diameters of the resin particles. However, it is apparent from the disclosure and would be understood by the artisan that the polymer and solvent are chosen so that the polymer will dissolve out of the solvent and form either a coating on the pigment or a particle with the pigment embedded. This controls the size of the toner particle. The artisan would understand that the solubility parameter of each component (inherently a property of each component) would control the size of the particle or thickness of the polymer coating on the pigment. The Examiner maintains the position that the artisan would have found it obvious to choose a combination of polymer and solvent so that cooling (i.e., precipitation temperature) can be performed to room temperature rather than 0C as performed in Example 2 of Hou. This would have been advantageous because cooling to room temperature would require less time and less energy (e.g., an ice bath would not be required). Thus, the artisan would have found it obvious to choose a polymer for the toner of Hou where the solubility temperature is at room temperature for a given solvent to reduce time and expense of toner preparation.